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10/679,856

10/06/2003

Eric O. Bodnar

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EXAMINER

TRAN, PABLO N

ART UNIT

PAPER NUMBER

2618

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/679,856 | Applicant(s) BODNAR ET AL. | |
| | Examiner Pablo N. Tran | Art Unit 2618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 1-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/06/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The amendment filed 04/25/06 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "sensors", "a module selector", and "a directional navigation disc".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 53-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 53 and 58-59, new subject matter "sensors" was not disclosed in the specification as originally filed.

Regarding claim 56, new subject matter “a module selector” was not disclosed in the specification as originally filed.

Regarding claim 58, new subject matter “a directional navigation disc” was not disclosed in the specification as originally filed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 59 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 59, the claimed limitation “the data input sensors mimic sensors of the wireless communication device” renders the claim indefinite. How does the data input sensors mimic sensors of the wireless communication device? Appropriated correction required.

Regarding claim 63, the claimed limitation “wherein the housing includes at least one lateral recess to facilitate placement of the communication interface within a battery compartment of the wireless communication device” render the claim indefinite. If the housing includes a recess to facilitate placement of the communication interface, then the recess should be located somewhere within the housing rather than within the battery compartment of the wireless communication device? Appropriated correction required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 53-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross et al. (5,859,628).

As per claims 53 and 58-59, Ross et al. disclose a portable electronic organizer (fig. 5) comprising a housing having an upper surface and a lateral surface, a display (fig. 2/no. 202) supported by the housing and accessible at the upper surface, a first set of data input (fig. 2, keys) located at the upper surface, a second set of data input (fig. 2/no. 204, 206, col. 4/ln. 16-18) located at the lateral surface, a communication interface configured to communicate with a wireless communication device (col. 8/ln. 56-63), wherein the housing is configured so that a user may hold the housing such that the upper surface generally faces toward the user when the unit is being used as an organizer, so that the user has ready access to the first and second set of data input and can easily view information on the display (fig. 2).

As per claim 54, Ross et al. disclose the housing has a lower surface substantially opposite the upper surface and the lower surface being configured to receive the wireless communication device (col. 8/ln. 56-63).

As per claim 55, Ross et al. disclose the housing has a lower surface substantially opposite the upper surface and the communication interface is accessible at the lower surface (col. 8/ln. 56-63).

As per claim 56, Ross et al. disclose a processor (fig. 4/no. 404) and a memory (col. 6/ln. 45) configured to store at least two of a calendar module, an address module, a to do module, an appointment module, a time module, and a settings module (col. 8/ln. 46-50).

As per claim 57, Ross et al. disclose a touch screen (col. 2/ln. 2).

As per claim 60, Ross et al. disclose the communication interface communicates with the wireless communication device via a direct connection (col. 8/ln. 56-63).

As per claim 61, Ross et al. disclose a cellular phone (col. 8/ln. 56-63).

As per claim 62, Ross et al. disclose the communication interface is a port located in a battery compartment of the housing (fig. 1/no. 110, col. 8/ln. 56-63).

As per claim 63, Ross et al. disclose includes at least one lateral recess to facilitate placement of the communication interface (col. 8/ln. 56-63).

As per claim 64, Ross et al. disclose the wireless communication device include power sources independent of each other (col. 8/ln. 63).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (571)272-7898. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the

Art Unit: 2618

examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directauspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 8, 2006